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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL F. WILLIAMS, DAVID ALLISON BENNETT,
LYNN SHAINDELL GOLDHABER, DENNIS GLAVIN,
LORY ELIZABETH KRETT, CHARLES D. MENTZER,
STEPHEN M. TEGLOVIC, JOHN M. DIETZ, WILLIAM W. SMITH, III,
PAUL BILIBIN, JINYUE LIU, PAUL R. MC LAUGHLIN, SCOTT MEYER,
and SEAN HU

Appeal 2008-001302
Application 09/820,377
Technology Center 3600

Decided: October 30, 2009

Before, MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI and BIBHU R. MOHANTY, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants have filed a Request for Rehearing under 37 C.F.R.

§ 41.52(a)(3) (2007) of our Decision of May 29, 2008. The Decision affirmed the rejection of claims 7, 23-25 under 35 U.S.C. § 103(a) as being unpatentable over Gendreau in view of Stefik; reversed the rejection of claims 10-14 under 35 U.S.C.

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§ 103(a) as being unpatentable over Gendreau in view of Stefik, and further in view of Kara; reversed the rejection of claim 26 under 35 U.S.C. § 103(a) as being unpatentable over Gendreau in view of Stefik; and reversed the rejection of claim 7 under 35 U.S.C. § 112, first paragraph.

I. Appellants seek clarification of the status of claim 26 which was mistakenly grouped with the claims whose rejection we affirmed, instead of being grouped with the reversed claims. Claim 26 is reversed because it depends on claim 10, the rejection of which we reversed. We note this Board Panel did respond to Appellants' informal request for clarification by issuing a corrected Decision, but it appears that Appellants somehow never received this.

II. Appellants argue the Decision misapprehends Appellants' argument on Stefik disclosing that a "...usage right is directly related to the existing digital work to which it is attached ..." (Request 4). Appellants thus assert that this misapprehension led to our conclusion that

Appellants' arguments are not based on limitations appearing in the claims and are not commensurate with the broader scope of claim 7 which merely recites wherein the second user is designated in the memory accessible by the computer system as authorized to finalize shipping labels, and not designated to finalize only a given label as argued. In re Self, 671 F.2d 1344, 1348 (CCPA 1982). (Decision 11-12).

We disagree with Appellants because when examined word for word, the language of the claims remain incongruent with what Appellants argued.

The involved claim language reads:

“the second user is designated in the memory accessible by the computer system as authorized to finalize shipping labels....”

Appellants’ argument was:

“... a Stefik usage right is directly related to the existing digital work to which it is attached. As compared to a Stefik usage right that is directly related to the existing digital work to which it is attached...”

(Appeal Br. 31).

Thus, in a face to face comparison, the argument fails because it argues the feature of a usage right which is directly related to an existing digital work. Whereas, claim 7 does not recite any directly related feature with regard to Appellants’ argument "... the second user is designated ... to finalize only a given label ..." (Request 4). Thus, Appellants’ statement that “usage right is directly related to the existing digital work to which it is attached” is an argument directed to a given digital work, and thus is outside the scope of what is being claimed.

Appellants next argue that

Further, it is respectfully asserted that the above-mentioned argument ‘... that the recitation by Claim 7 of a restriction from finalizing shipping labels is a designation of a restriction associated with the user for taking a type of action, as compared to a right attached to a particular digital work ...,’ is based on the limitations of Claim 7, because Claim 7 claims a first user who ‘... is designated in a memory accessible by the computer system as restricted from finalizing shipping labels ...,’ and further claims receiving an input (comprising the machine-readable code that was generated in response to the request by the first user) from a second user (who ‘...

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is designated ... as authorized to finalize shipping labels') for finalizing a shipping label for shipping the parcel. See Claim 7; see also, Appeal Brief, p. 36. (Request 5).

However, the distinction which Appellants argue between a restriction associated with a user for taking a type of action in finalizing shipping labels, and a right attached to a particular digital work, is not persuasive because if the right is not so attached, then the given first user could not be restricted from taking action in favor of the second user's authorization.

III. Appellants challenge the position taken by the Board that "[t]he act of printing data onto a shipping label is itself a form of copying, namely, the data which resides in the buffer of a printer is copied onto the label substrate in human-readable form as part of the printing process." (Request 7). Specifically, Appellants assert

...it is respectfully asserted that printing data which already resides in a print buffer, is not equivalent to the claimed limitations of Claim 7 for retrieving partial shipment information from a memory according to a code input by a second user and then generating a shipment label according to the retrieved partial shipment information and according to input by the second user. (Request 7).

We disagree with Appellants because Appellants' argument seek a step wise limitation to the recitations of "*retrieve from the memory the set of partial shipment information according to the machine-readable code; and generate a shipping label comprising at least a first item of information from the*

set of partial shipment information and according to the input from the second user." However, our reading of these phrases in claim 7 reveals no required ordering of steps as argued by Appellants. In fact, each step, recites the set of partial shipment information using the definite article "the" which would indicate that no one of these steps serves as an antecedent to the other. Appellants in their Request on page 8 seek the description of the Specification to support their argument that these steps should be interpreted in the order so argued, but we reject this argument because limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily).

IV. Appellants argue as compared with claim 7, "...the Gendreau invoice "preexists" the Gendreau system (See Appeal Brief, p. 37), and further that the information in Gendreau, which, according to Gendreau, is shipment information in computer-readable form, must be "input" into the Gendreau system." (Request 10). We disagree with Appellants because our Finding 7 found that:

Gendreau discloses that the invoice has computer-readable information and need not be attached to the parcel but rather "...the invoice 22 may be a printed document that travels with but is not connected to the parcel (i.e., at least associating computer-readable information with the parcel via an associated order request). (Gendreau, ¶[0032]).

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As such, we read the use in Gendreau of the associated computer-readable information by the system as a generating step because the data is generated from memory and subsequently used.

Appellants further argue that:

...the shipment information does not, prior to having been input, exist within the Gendreau system, there is no relationship saved in a memory in the Gendreau system between the computer-readable shipment information and a code that can be used to retrieve the shipment information. That is, contrary to the above-mentioned inference in the Appeal Decision that Gendreau maintains a relationship between the a computer-readable code and the Gendreau shipment information it is respectfully asserted that the computer-readable Gendreau information is itself, shipment information, not a code with which to retrieve shipment information as claimed by Claim 7 (claiming "... retrieve from the memory the set of partial shipment information according to the machine-readable code"). (Request 11).

We disagree with Appellants because the argument again fails to recognize the alternative embodiment set forth in our Decision at (FF 7) which finds that Gendreau discloses using code instead of printed data. When this finding is taken in conjunction with our stated inference that "... a computer system which receives the machine readable code and which maintains a relationship between the code and the shipment information would somehow save this information either in a database or in a printer buffer as the label is printed" (Decision, 12-13), the claim limitation is met.

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In addition, Appellants again argue a sequence of steps, namely:

... that because the shipment information does not, prior to having been input, exist within the Gendreau system, there is no relationship saved in a memory in the Gendreau system between the computer-readable shipment information and a code that can be used to retrieve the shipment information. (Request 11).

We disagree with Appellants because, again, there is no requirement in claim 7 to address the steps in a given order as argued. Second, Gendreau, as discussed, above discloses an embodiment where the associated computer readable information is used in lieu of printed data on a box, and thus in this situation the system would by inference need to maintain such information in relationship to its shipment information. This specific inference is not challenged by Appellants.

We conclude:

Our decision to affirm the decision of the Examiner to reject claims 7, 23-25 on appeal under 35 U.S.C. § 103(a) over Gendreau in view of Stefik has not been shown to have been erroneous.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REHEARING DENIED

JRG

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